

RECEIVED
CENTRAL FAX CENTER

JAN 27 2005

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/769,939	
	Filing Date	01/26/2001	
	First Named Inventor	CALVERT, ET AL.	
	Group Art Unit	2686	
	Examiner Name	QUINONES, ISMAEL C.	
Total Number of Pages in this Submission	27	Attorney Docket Number	PF01763NA


ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/Declaration(s) <input type="checkbox"/> Extension of time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Documents <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts Under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-Related papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CDs Remarks	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter with appropriate copies <input type="checkbox"/> Other Enclosure(s) (please identify below) <input type="checkbox"/> Response to Restriction Requirement <input type="checkbox"/> Associate Power of Attorney <input type="checkbox"/> RCE <input type="checkbox"/> Copy of Notice to File Missing Parts

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	Sylvia Chen	Registration No.	39,633
Signature	<i>Sylvia Chen</i>		
Date	January 26, 2005		

CERTIFICATE OF TRANSMITTAL/MAILING

I hereby certify that this correspondence is being facsimile transmitted to facsimile number <u>703-872-9306</u> or deposited with the United States Postal Service with sufficient postage thereon, as first-class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313 on the date listed below:			
Typed or printed name	June Edwards		
Signature	<i>June Edwards</i>	Date	January 26, 2005

FEE TRANSMITTAL Patent fees are subject to annual revision <input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27					Complete if Known																																																																			
TOTAL AMOUNT OF PAYMENT (\$)					500.00	Application Number	09/769,939																																																																	
METHOD OF PAYMENT (check all that apply)						Filing Date	01/26/2001																																																																	
Check	<input type="checkbox"/>	Credit card	<input type="checkbox"/>	Money Order	<input type="checkbox"/>	Other	<input type="checkbox"/>	None	<input type="checkbox"/>	First Named Inventor	CALVERT, ET AL																																																													
<input checked="" type="checkbox"/> Deposit Account: Deposit Account Number 502117 Deposit Account Name Motorola, Inc. The Director is authorized to: (check all that apply) <input checked="" type="checkbox"/> Charge fee(s) indicated below <input checked="" type="checkbox"/> Credit any overpayments <input checked="" type="checkbox"/> Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 <input type="checkbox"/> Charge fees(s) indicated below, except for the filing fee to the above-identified deposit account.					Examiner Name			QUINONES, ISMAEL C.																																																																
					Group Art Unit			2686																																																																
					Attorney Docket No.			PF01763NA																																																																
FEE CALCULATION					FEE CALCULATION (continued)																																																																			
1. BASIC FILING, SEARCH, AND EXAMINATION FEES					4. ADDITIONAL FEES																																																																			
<table border="1" style="width:100%"><thead><tr><th rowspan="2">Application Type</th><th colspan="2">FILING FEES</th><th colspan="2">SEARCH FEES</th><th colspan="2">EXAMINATION FEES</th><th rowspan="2">Fee Paid (\$)</th></tr><tr><th>Large Fee (\$)</th><th>Small Entity Fee (\$)</th><th>Large Fee (\$)</th><th>Small Entity Fee (\$)</th><th>Large Fee (\$)</th><th>Small Entity Fee (\$)</th></tr></thead><tbody><tr><td>Utility</td><td>300</td><td>150</td><td>500</td><td>250</td><td>200</td><td>100</td><td></td></tr><tr><td>Design</td><td>200</td><td>100</td><td>100</td><td>50</td><td>130</td><td>65</td><td></td></tr><tr><td>Plant</td><td>200</td><td>100</td><td>300</td><td>150</td><td>180</td><td>80</td><td></td></tr><tr><td>Reissue</td><td>300</td><td>150</td><td>500</td><td>250</td><td>600</td><td>300</td><td></td></tr><tr><td>Provisional</td><td>200</td><td>100</td><td>0</td><td>0</td><td>0</td><td>0</td><td></td></tr></tbody></table>					Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fee Paid (\$)	Large Fee (\$)	Small Entity Fee (\$)	Large Fee (\$)	Small Entity Fee (\$)	Large Fee (\$)	Small Entity Fee (\$)	Utility	300	150	500	250	200	100		Design	200	100	100	50	130	65		Plant	200	100	300	150	180	80		Reissue	300	150	500	250	600	300		Provisional	200	100	0	0	0	0		<table border="1" style="width:100%"><thead><tr><th>Fee (\$)</th><th>Small Entity Fee (\$)</th></tr></thead><tbody><tr><td>50</td><td>25</td></tr><tr><td>200</td><td>100</td></tr><tr><td>360</td><td>180</td></tr></tbody></table>			Fee (\$)	Small Entity Fee (\$)	50	25	200	100	360	180			
Application Type	FILING FEES		SEARCH FEES			EXAMINATION FEES		Fee Paid (\$)																																																																
	Large Fee (\$)	Small Entity Fee (\$)	Large Fee (\$)	Small Entity Fee (\$)	Large Fee (\$)	Small Entity Fee (\$)																																																																		
Utility	300	150	500	250	200	100																																																																		
Design	200	100	100	50	130	65																																																																		
Plant	200	100	300	150	180	80																																																																		
Reissue	300	150	500	250	600	300																																																																		
Provisional	200	100	0	0	0	0																																																																		
Fee (\$)	Small Entity Fee (\$)																																																																							
50	25																																																																							
200	100																																																																							
360	180																																																																							
2. EXTRA CLAIM FEES Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent Multiple Dependent Claims Total Claims: 20 or HP = <input type="text"/> x 50 = <input type="text"/> HP = highest number of total claims paid for, if greater than 3 Indep. Claims: 3 or HP = <input type="text"/> x 200 = <input type="text"/> 3. APPLICATION SIZE FEE If the specification and drawings exceed 100 sheets of paper, the application size fee is \$250 (\$125 for small entity) For each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s). Total Sheets: 100 = <input type="text"/> 750 = <input type="text"/> (round up to a whole number) x 250 = <input type="text"/>					<table border="1" style="width:100%"><thead><tr><th>Fee (\$)</th><th>Small Entity Fee (\$)</th></tr></thead><tbody><tr><td>500</td><td>250</td></tr><tr><td>1000</td><td>500</td></tr><tr><td>1500</td><td>750</td></tr><tr><td>2000</td><td>1000</td></tr><tr><td>2500</td><td>1250</td></tr><tr><td>3000</td><td>1500</td></tr><tr><td>3500</td><td>1750</td></tr><tr><td>4000</td><td>2000</td></tr><tr><td>4500</td><td>2250</td></tr><tr><td>5000</td><td>2500</td></tr><tr><td>5500</td><td>2750</td></tr><tr><td>6000</td><td>3000</td></tr><tr><td>6500</td><td>3250</td></tr><tr><td>7000</td><td>3500</td></tr><tr><td>7500</td><td>3750</td></tr><tr><td>8000</td><td>4000</td></tr><tr><td>8500</td><td>4250</td></tr><tr><td>9000</td><td>4500</td></tr><tr><td>9500</td><td>4750</td></tr><tr><td>10000</td><td>5000</td></tr></tbody></table>			Fee (\$)	Small Entity Fee (\$)	500	250	1000	500	1500	750	2000	1000	2500	1250	3000	1500	3500	1750	4000	2000	4500	2250	5000	2500	5500	2750	6000	3000	6500	3250	7000	3500	7500	3750	8000	4000	8500	4250	9000	4500	9500	4750	10000	5000																							
Fee (\$)	Small Entity Fee (\$)																																																																							
500	250																																																																							
1000	500																																																																							
1500	750																																																																							
2000	1000																																																																							
2500	1250																																																																							
3000	1500																																																																							
3500	1750																																																																							
4000	2000																																																																							
4500	2250																																																																							
5000	2500																																																																							
5500	2750																																																																							
6000	3000																																																																							
6500	3250																																																																							
7000	3500																																																																							
7500	3750																																																																							
8000	4000																																																																							
8500	4250																																																																							
9000	4500																																																																							
9500	4750																																																																							
10000	5000																																																																							
					5. OTHER FEE(S) (specify) Non-English Specification, \$130 fee (no small entity discount) Fee Paid (\$)																																																																			
SUBMITTED BY					Registration No.			39,633	Telephone	847-523-2586																																																														
Name (Print/Type)					Sylvia Chen																																																																			
Signature								Date			January 26, 2005																																																													

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: CALVERT ET AL. ART UNIT: 2686
APPLN. NO.: 09/769,939 EXAMINER: QUINONES, ISMAEL C
FILED: 01/26/2001
TITLE: METHOD AND APPARATUS FOR ACCURATELY LOCATING
A COMMUNICATION DEVICE IN
A WIRELESS COMMUNICATION SYSTEM

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
CENTRAL FAX CENTER

JAN 27 2005

Attention: Board of Patent Appeals and Interferences

Dear Chief Administrative Patent Judge:

This Appeal Brief is in furtherance of the Notice of Appeal, transmitted on November 24, 2004 with a one-month Extension of Time transmitted on November 29, 2004.

The fees required under 37 C.F.R. § 41.20(b)(2), and any required petition for extension of time for filing this Appeal Brief and fees therefor, are dealt with in the accompanying Transmittal Form.

This brief is being transmitted by facsimile pursuant to 37 C.F.R. § 1.6(d).

This brief contains items under the headings listed in the following Table of Contents, and in the order indicated in 37 C.F.R. § 41.37(c).

Application No. 09/769,939
January 26, 2005
Page 2 of 25

Docket No. PT01763NA

TABLE OF CONTENTS

	Page
I. Real Party in Interest	3
II. Related Appeals and Interferences	3
III. Status of Claims.....	3
IV. Status of Amendments.....	3
V. Summary of Claimed Subject Matter	4
VI. Grounds of Rejection to be Reviewed on Appeal	5
VII. Argument.....	5
VIII. Claims Appendix	16

Application No. 09/769,939
January 26, 2005
Page 3 of 25

Docket No. PT01763NA

I. REAL PARTY IN INTEREST

Motorola, Inc., a Delaware corporation, is the real party in interest by Assignment of this application executed by the inventors on December 29, 2000, January 10, 2001, and December 6, 2000 and recorded on January 26, 2001 at Reel 011509 Frame 0160 at the U.S. Patent and Trademark Office.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

This is an appeal from the final rejection of claims 1-42 of the above-referenced application.

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 42

B. STATUS OF ALL THE CLAIMS

1. Claims allowed: none
2. Claims objected to: none
3. Claims rejected: 1-42

C. CLAIMS ON APPEAL

The claims on appeal are: 1-42

IV. STATUS OF AMENDMENTS

No amendments were filed subsequent to final rejection.

Application No. 09/769,939
January 26, 2005
Page 4 of 25

Docket No. PT01763NA

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter involves a method and apparatus for accurately locating a communication device in a wireless communication system. A system infrastructure determines an approximate geographic location of the communication device. Based on the approximate geographic location, the system infrastructure transmits a request for more accurate geographic location to the communication device possibly together with a map of an area that includes the approximate geographic location. Responsive to user input to the communication device that gives more accurate geographic location, the communication device transmits the more accurate geographic location to the system infrastructure. After receiving the more accurate geographic location, the system infrastructure conveys the more accurate geographic location to a target device.

By accurately locating a communication device in this manner, the communication device (and its user) can be precisely located by the system infrastructure. Because the location of the device is determined with input from the user of the device, the location of the device can be determined accurately both horizontally and vertically, regardless of the device's location. By contrast, although prior art systems that incorporate GPS receivers in the communication devices can determine mobile device location fairly accurately horizontally (e.g., within ten meters), they are much less accurate in locating the device vertically and/or when the device is inside a building or in any other area having obscured access to the orbiting global positioning satellites. In addition, although GPS technology is relatively accurate, the inclusion of such technology in mobile communication devices can increase the cost of such devices substantially as compared to the cost of such devices without GPS technology.

Application No. 09/769,939
January 26, 2005
Page 5 of 25

Docket No. PT01763NA

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Overall, the appeal centers on whether Pub. No. US 2003/0195008 A1 to Mohi et al. (Mohi 2003) was properly applied as a "prior art" reference when Mohi 2003 was filed after the filing date of the present application. The specific grounds of rejection to be reviewed on appeal are as follows, and Mohi 2003 is a key reference used by the Examiner in each rejection.

1.1. Whether claims 1-19, 22-35, 37-40, and 42 are patentable under 35 U.S.C. 103(a) over Pat. No. US 6,289,279 B1 to Ito et al. (Ito) in view of Pub. No. US 2003/0195008 A1 to Mohi et al. (Mohi 2003), further in view of Pat. No. US 6,115,611 to Kimoto et al. (Kimoto).

1.2. Whether claims 20-21 are patentable under 35 U.S.C. 103(a) over Pat. No. US 6,289,279 B1 to Ito et al. (Ito) in view of Pub. No. US 2003/0195008 A1 to Mohi et al. (Mohi 2003), further in view of Pat. No. US 6,115,611 to Kimoto et al. (Kimoto) and Pat. No. US 6,393,292 B1 to Lin (Lin).

1.3. Whether claims 36 and 41 are patentable under 35 U.S.C. 103(a) over Pat. No. US 6,289,279 B1 to Ito et al. (Ito) in view of Pub. No. US 2003/0195008 A1 to Mohi et al. (Mohi 2003).

VII. ARGUMENT

1. Mohi 2003 is Not Prior Art Relative to the Present Application

The Examiner has failed to establish that Mohi 2003, filed on April 23, 2003, qualifies as prior art relative to the present application, which was filed on January 26, 2001. Consequently, Mohi 2003 was inappropriately cited against each of the present claims. Thus, the Examiner has failed to present a prima facie case of obviousness, which would necessitate a technical response by the Applicant. In other words, the Examiner's rejection continues to be improperly supported and/or defective, and has never been properly established such that a technical response by the Applicant would be required.

Application No. 09/769,939
January 26, 2005
Page 6 of 25

Docket No. PT01763NA

Each of the Examiner's rejections relies heavily on Mohi 2003 filed on April 23, 2003. Mohi 2003 is a continuation-in-part of Pub. No. US 2002/0006800 to Mohi (Mohi 2002) filed July 5, 2001. Mohi 2002 is a non-provisional application of provisional application no. 60/218,454 filed on July 14, 2000. Mohi 2003 claims continuation-in-part priority to Mohi 2002. Although the front page and paragraph [0001] of Mohi 2003 lists the related provisional application, *Mohi 2003 is not co-pending with the provisional application* and thus cannot claim priority directly from the Mohi provisional application; any claim to the July 14, 2000 priority date of the Mohi provisional application is through Mohi 2002 and, therefore, any material from Mohi 2003 that could obtain the benefit of the Mohi provisional application filing date must be supported by Mohi 2002.

Through Mohi 2002, Applicant is fully aware of the relevant degree of disclosure of the Mohi provisional application and can assert with confidence the portions of Mohi 2003 that have (and do not have) privilege to the earliest filing date of July 14, 2000. See *In re Wertheim*, 646 F.2d 527, 209 USPQ 554 (CCPA 1981) summarized in MPEP 2136.03 IV. Applicant shall assume that the Board is familiar with the facts and holding of *In re Wertheim*. In the present situation, as opposed to *In re Wertheim*, Applicant has the benefit of Mohi 2002, which is essentially the publication of the Mohi provisional application. By comparing Mohi 2003 with Mohi 2002, it is very clear as to what portions of Mohi 2003 are entitled to the earliest priority date. Additionally, Applicant submitted Mohi 2002 in a May 3, 2004 Information Disclosure Statement, which the Examiner has considered but not cited in his rejections.

Mohi 2003 has additional inventors and several embodiments that are not contained in Mohi 2002, which are not entitled to the Mohi provisional application filing date of July 14, 2000. These further embodiments, starting on page 5 at paragraph [0082], include the concept of the rover receiving AGPS information from a controller and then the rover providing either GPS location data or raw GPS data to the controller for accurately determining the location of the rover. Mohi 2003 starting at paragraph

Application No. 09/769,939
January 26, 2005
Page 7 of 25

Docket No. PT01763NA

[0082] is only entitled to a filing date of April 23, 2003, which is after the January 26, 2001 filing date of the present application. Thus, significant portions of Mohi 2003 are not prior art relative to the present application, and the Examiner cannot rely upon any Mohi 2003 paragraph greater than [0081] in his rejection of the present application.

By definition, a continuation-in-part application means that additional subject matter has been added to the application from which the continuation-in-part application claims priority (see MPEP 201.08). In attempting to justify the appropriateness of using the earliest priority date of July 14, 2000 in association with the entirety of Mohi 2003, the Examiner states that Mohi 2003 is entitled to the earlier provisional date "based on its relevance or correspondence to Mohi 2002, furthermore both references [Mohi 2002 and Mohi 2003] showing or disclosing Applicant's invention."

First of all, the Examiner has utterly failed to recite how Mohi 2002 shows or discloses Applicant's invention. No Office Action cites any portion of Mohi 2002 either directly or via an analogous paragraph in Mohi 2003.

Next, a "relevance or correspondence" between Mohi 2002 and Mohi 2003 does not entitle the entirety of Mohi 2003 to the earliest priority date of July 14, 2000. In fact, it is wholly expected to have "relevance and correspondence" between a continuation-in-part application and the application from which it depends. This relevance and correspondence does not mean that all of Mohi 2003 is entitled to the same priority date as the portions of Mohi 2003 that are repeated from Mohi 2002.

Given that the Examiner has replied upon non-prior-art portions of Mohi 2003 in the rejection of each of the claims of the present application, reconsideration and withdrawal of all the outstanding rejections is respectfully requested.

Application No. 09/769,939
January 26, 2005
Page 8 of 25

Docket No. PT01763NA

1.1 Claims 1-19, 22-35, 37-40, and 42 are Patentable under 35 U.S.C. 103(a)
over Ito in view of Mohi 2003, further in view of Kimoto

1.1.1. Claims 1-19

Regarding claim 1, the portions of Mohi 2003 that are entitled to the Mohi provisional application filing date of July 14, 2000 do not show or suggest the steps of "transmitting to the communication device, based on the approximate geographic location, at least a request for a more accurate geographic location of the communication device; receiving from the user input device of the communication device the more accurate geographic location; and conveying the more accurate geographic location to a target device." Paragraphs [0103] and [0145] of Mohi 2003 relied upon by the Examiner for rejecting claim 1 are new matter relative to Mohi 2002 and are entitled only to the filing date of April 23, 2003 for Mohi 2003, which is after the January 26, 2001 filing date of the present application.

Although Kimoto suggests that a user can input his/her own current position according to a map displayed on the mobile terminal (col. 50 lines 24-28), Kimoto and Ito also fail to show or suggest the steps of "transmitting to the communication device, based on the approximate geographic location, at least a request for a more accurate geographic location of the communication device" and subsequently "receiving . . . the more accurate geographic location" and "conveying the more accurate geographic location to a target device" as recited in claim 1.

Because Ito, the portions of Mohi 2003 that are entitled to the provisional application filing date of July 14, 2000, and Kimoto do not show or suggest at least the step of "transmitting to the communication device, based on the approximate geographic location, at least a request for a more accurate geographic location of the communication device," claim 1 is not obvious in view of Ito, the prior art portions of Mohi 2003, and Kimoto.

Application No. 09/769,939
January 26, 2005
Page 9 of 25

Docket No. PT01763NA

Claims 2-19 depend directly or indirectly upon independent claim 1 and, therefore, are also not obvious in view of Ito, the prior art portions of Mohi 2003, and Kimoto.

1.1.2. Claims 22-32

Claim 22 recites the steps of "displaying the request on the communication device; receiving, from the user input device, the accurate geographic location of the communication device; and transmitting the accurate geographic location to the system infrastructure for subsequent delivery to the target device." Paragraphs [0103], [0108], [0118], and [0145] of Mohi 2003 that the Examiner asserts as showing these steps belong to the further embodiments starting on page 5 at paragraph [0082] that are not contained in Mohi 2002, and thus these sections of Mohi 2003 are entitled only to the filing date of April 23, 2003 for Mohi 2003, which is after the January 26, 2001 filing date of the present application.

Additionally, the display of a map after the location of the rover has been determined, as described in Mohi 2003, is not "displaying the request on the communication device" as recited in claim 22. The map of Mohi 2003 clearly provides information rather than requests information. See paragraphs [0108] and [0118] of Mohi 2003. Regarding Kimoto, because there is no suggestion of the information center 2B requesting accurate geographic information of the communication device, there is no suggestion to display such a request.

Because Ito, the portions of Mohi 2003 that are entitled to the provisional application filing date of July 14, 2000, and Kimoto do not show or suggest "displaying the request on the communication device," as well as receiving the request and responding to the request, claim 22 is not obvious in view of Ito, the prior art portions of Mohi 2003, and Kimoto.

Application No. 09/769,939
January 26, 2005
Page 10 of 25

Docket No. PT01763NA

Claims 23-32 depend directly or indirectly upon independent claim 22 and, therefore, are also not obvious in view of Ito, the prior art portions of Mohi 2003, and Kimoto.

1.1.3. Claims 33-34

Regarding claim 33, Ito, the portions of Mohi 2003 that are entitled to the provisional application filing date of July 14, 2000, and Kimoto do not show or suggest "receiving, from the system infrastructure, a request for an accurate geographic location of the communication device and a map of an area that includes an approximate geographic location of the communication device; displaying at least the map on the communication device; receiving, from the user input device, an indication on the map corresponding to a location of the communication device; and conveying the location of the communication device to the system infrastructure for subsequent delivery to the target device." First, paragraphs [0108] and [0118] of Mohi 2003 are new matter relative to Mohi 2002 and are entitled only to the filing date of April 23, 2003 for Mohi 2003, which is after the January 26, 2001 filing date of the present application. Second, Mohi 2003 fails to show or suggest the step of "receiving, from the user input device, an indication on the map corresponding to a location of the communication device." As discussed previously, Kimoto also fails to show or suggest the step of "receiving . . . a request for an accurate geographic location of the communication device and a map." Thus, claim 33 is not obvious in view of Ito, the prior art portions of Mohi 2003, and Kimoto.

Claim 34 depends directly upon independent claim 33 and, therefore, is not obvious in view of Ito, the prior art portions of Mohi 2003, and Kimoto.

1.1.4. Claim 35

Claim 35 recites the steps of "receiving, from the system infrastructure, a request for an accurate geographic location of the communication device and a first map of an

Application No. 09/769,939
January 26, 2005
Page 11 of 25

Docket No. PT01763NA

area that includes a first approximate geographic location of the communication device; displaying at least the first map on the communication device; receiving, from the user input device, an indication on the first map corresponding to a second approximate geographic location of the communication device, the second approximate geographic location being more accurate than the first approximate geographic location; conveying the second approximate geographic location and a request for a second map to the system infrastructure; receiving the second map from the system infrastructure, the second map corresponding to an area that includes the second approximate geographic location and being of a higher resolution than the first map; displaying the second map on the communication device; receiving, from the user input device, an indication on the second map corresponding to a location of the communication device; and conveying the location of the communication device to the system infrastructure for subsequent delivery to the target device," which are not shown or suggested by Ito, the portions of Mohi 2003 that are entitled to the provisional application filing date of July 14, 2000, and Kimoto.

First, paragraph [103] and [145] of Mohi 2003 are new matter relative to Mohi 2002 and thus are entitled only to the filing date of April 23, 2003 for Mohi 2003, which is after the January 26, 2001 filing date of the present application. Second, the maps mentioned in Ito column 5 lines 33-36 and 48-52 and Mohi 2003 paragraphs [0058], [0059], [0080], [0081], [0098] clearly display information and do not assist in receiving information as recited in claim 35 as "receiving, from the user input device, an indication on the first map corresponding to a second approximate geographic location of the communication device." Although Mohi 2003 paragraph [0059] mentions continuing data from the rover unit, none of the cited references show or suggest receiving this continuing information from a user input device as recited in claim 35. Regarding the step of "receiving the second map" recited in claim 35, the Examiner refers to a portion of Mohi 2003 that is not entitled to the Mohi provisional application filing date of July 14, 2000.

Application No. 09/769,939
January 26, 2005
Page 12 of 25

Docket No. PT01763NA

Kimoto, although proposing that a user can input his/her own current position according to a map displayed on the mobile terminal (col. 50 lines 24-28), fails to address the shortcomings of Mohi 2003 described above and also fails to show or suggest the steps of "conveying the second approximate geographic information and a request for a second map to the system infrastructure" as recited in claim 35. Thus, claim 35 is not obvious in view of Ito, the prior art portions of Mohi 2003, and Kimoto.

1.1.5. Claims 37-40

Claims 37-40 depend directly or indirectly upon independent claim 36. Thus, the rejection of claim 36 is discussed here. Neither Ito nor the prior art portions of Mohi 2003 show or suggest "a display . . . for displaying the request on the communication device" as recited in claim 36. The portions of Mohi 2003 (paragraphs [108] and [118]) that are relied upon by the Examiner are new matter relative to Mohi 2002 and thus are entitled only to the filing date of April 23, 2003 for Mohi 2003, which is after the January 26, 2001 filing date of the present application. Additionally, neither Mohi 2003 nor Ito show or suggest "a user input device for receiving, from the user, information corresponding to the accurate geographic location of the communication device." At best, Mohi 2003 (in paragraphs that are *not* prior art relative to this patent application) suggests the use of information corresponding to the accurate geographic location that are *not* received from the user but rather generated by a GPS module within the rover. See Mohi 2003 paragraphs [0059] and [0072]. Thus, claim 36 is not obvious in view of Ito and the prior art portions of Mohi 2003.

Claims 37-40 depend directly or indirectly upon independent claim 36. As mentioned previously, Kimoto fails to address the shortcomings of Ito and the prior art portions of Mohi 2003 with respect to claim 36. Thus, claims 37-40 are not obvious in view of Ito, the prior art portions of Mohi 2003, and Kimoto.

Application No. 09/769,939
January 26, 2005
Page 13 of 25

Docket No. PT01763NA

1.1.6. Claim 42

Claims 42 depends directly upon independent claim 41. Thus, the rejection of claim 41 is discussed here. Regarding claim 41, neither Ito nor the prior art portions of Mohi 2003 show or suggest "a user input device for receiving, from the user, an indication on the map corresponding to a location of the communication device." FIG. 17 of Mohi 2003 (which is prior art because it was disclosed in Mohi 2002) shows an interactive map. The interaction, however, relates to the scope of the map; nothing in Mohi 2002 or Mohi 2003 even hints at the map being a tool for a user to indicate the location of the communication device. Thus, claim 41 is not obvious in view of Ito and Mohi 2003.

Claim 42 depends directly upon independent claim 41. Kimoto fails to address the shortcomings of Ito and the prior art portions of Mohi 2003 with respect to claim 41. Thus, claim 42 is not obvious in view of Ito, the prior art portions of Mohi 2003, and Kimoto.

1.2. Claims 20-21 are Patentable under 35 U.S.C. 103(a) over Ito in view of Mohi 2003, further in view of Kimoto and Lin

Claims 20-21 depend directly or indirectly upon independent claim 1 discussed in Section 1.1.1. Lin fails to address the shortcomings of Ito, the prior art portions of Mohi 2003, and Kimoto with respect to claim 1 described above. Thus claims 20-21 are not obvious in view of Ito, the prior art portions of Mohi 2003, Kimoto, and Lin.

1.3. Claims 36 and 41 are Patentable under 35 U.S.C. 103(a) over Ito in view of Mohi 2003

1.3.1. Claim 36

Neither Ito nor the prior art portions of Mohi 2003 show or suggest "a display . . . for displaying the request on the communication device" as recited in claim 36. The

Application No. 09/769,939
January 26, 2005
Page 14 of 25

Docket No. PT01763NA

portions of Mohi 2003 (paragraphs [108] and [118]) that are relied upon by the Examiner are new matter relative to Mohi 2002 and thus are entitled only to the filing date of April 23, 2003 for Mohi 2003, which is after the January 26, 2001 filing date of the present application. Additionally, neither Mohi 2003 nor Ito show or suggest "a user input device for receiving, from the user, information corresponding to the accurate geographic location of the communication device." At best, Mohi 2003 (in paragraphs that are *not* prior art relative to this patent application) suggests the use of information corresponding to the accurate geographic location that are *not* received from the user but rather generated by a GPS module within the rover. See Mohi 2003 paragraphs [0059] and [0072]. Thus, claim 36 is not obvious in view of Ito and the prior art portions of Mohi 2003.

1.3.2. Claim 41

Regarding claim 41, neither Ito nor the prior art portions of Mohi 2003 show or suggest "a user input device for receiving, from the user, an indication on the map corresponding to a location of the communication device." FIG. 17 of Mohi 2003 (which is prior art because it was disclosed in Mohi 2002) shows an interactive map. The interaction, however, relates to the scope of the map; nothing in Mohi 2002 or Mohi 2003 even hints at the map being a tool for a user to indicate the location of the communication device. Thus, claim 41 is not obvious in view of Ito and Mohi 2003.

Conclusion

For the reasons set forth, and as is apparent from a review of the above-cited references, the pending claims 1-42 present patentable subject matter such that reversal of the rejections is appropriate.

Application No. 09/769,939
January 26, 2005
Page 15 of 25

Docket No. PT01763NA

Respectfully submitted,

Please send correspondence to:
Motorola, Inc.
Intellectual Property Dept. (SYC)
600 North U.S. Highway 45, AS437
Libertyville, IL 60048
Customer Number: 20280

By: Sylvia Chen 26 JAN 2005
Sylvia Chen Date
Attorney for Applicant
Registration No. 39,633
Tel. No. (847) 523-1096
Fax No. (847) 523-2350
Email: Sylvia.Chen@motorola.com

Application No. 09/769,939
January 26, 2005
Page 16 of 25

Docket No. PT01763NA

VIII. CLAIMS APPENDIX

1 (currently amended). A method for a system infrastructure of a wireless communication system to accurately locate a communication device with a user input device in the wireless communication system, the method comprising the steps of:

determining an approximate geographic location of the communication device;
transmitting to the communication device, based on the approximate geographic location, at least a request for a more accurate geographic location of the communication device;

receiving from the user input device of the communication device the more accurate geographic location; and

conveying the more accurate geographic location to a target device.

2 (original). The method of claim 1, further comprising the step of, prior to the step of determining the approximate geographic location of the communication device, receiving a request for a geographic location of the communication device from a requesting device, the request identifying the target device.

3 (original). The method of claim 2, wherein the requesting device is the target device.

4 (original). The method of claim 2, wherein the requesting device is the communication device.

5 (original). The method of claim 1, wherein the step of transmitting further comprises the step of transmitting to the communication device a map of an area that includes the approximate geographic location of the communication device.

6 (original). The method of claim 5, wherein the step of receiving the more accurate

Application No. 09/769,939
January 26, 2005
Page 17 of 25

Docket No. PT01763NA

geographic location comprises the step of receiving information identifying a location of the communication device on the map.

7 (original). The method of claim 6, wherein the information identifying a location of the communication device on the map comprises a modified representation of the map indicating the location of the communication device.

8 (original). The method of claim 7, wherein the information identifying a location of the communication device on the map further comprises textual information and graphical information further identifying the location of the communication device.

9 (original). The method of claim 5, wherein the step of receiving the more accurate geographic location further comprises the step of receiving information identifying a second approximate location of the communication device on the map and a request for a second map corresponding to an area that includes the second approximate location, the second map being of a higher resolution than the map of the area that includes the approximate geographic location of the communication device, and wherein the method further comprises the step of transmitting the second map to the communication device.

10 (currently amended). The method of claim 9, wherein the step of receiving the more accurate geographic location further comprises the step of receiving information from the user input device identifying a location of the communication device on the second map.

11 (original). The method of claim 1, wherein the step of transmitting further comprises the step of transmitting to the communication device a textual description of an area that includes the approximate geographic location of the communication device.

Application No. 09/769,939
January 26, 2005
Page 18 of 25

Docket No. PT01763NA

12 (original). The method of claim 1, wherein the step of determining an approximate geographic location of the communication device comprises the steps of:

transmitting a request to the communication device for the approximate geographic location; and

receiving the approximate geographic location from the communication device responsive to the transmitted request.

13 (original). The method of claim 1, wherein the step of conveying the more accurate geographic location to the target device comprises the step of conveying a map to the target device, wherein the map indicates the more accurate geographic location.

14 (original). The method of claim 1, wherein the step of conveying the more accurate geographic location to the target device comprises the step of conveying a textual description of the more accurate geographic location to the target device.

15 (original). The method of claim 1, wherein the more accurate geographic location includes information indicating a height of the communication device.

16 (original). The method of claim 1, further comprising the steps of:

determining a location of the target device; and

conveying supplemental information related to both the location of the target device and the more accurate geographic location of the communication device to the target device.

17 (original). The method of claim 16, wherein the supplemental information is based on a distance between the communication device and the target device.

Application No. 09/769,939
January 26, 2005
Page 19 of 25

Docket No. PT01763NA

18 (original). The method of claim 17, wherein the supplemental information comprises at least one of a city, a state, and a country when the communication device is located a substantial distance from the target device.

19 (original). The method of claim 16, wherein the supplemental information comprises at least one of directions to the more accurate geographic location of the communication device from the location of the target device, an approximate distance between the more accurate geographic location of the communication device and the location of the target device, and an approximate commute time between the location of the target device and the more accurate geographic location of the communication device.

20 (original). The method of claim 1, further comprising the steps of:

prior to the step of transmitting at least a request:

determining whether the approximate geographic location of the communication device is different than a previous approximate geographic location of the communication device; and

when the approximate geographic location of the communication device is different than a previous approximate geographic location of the communication device, automatically transmitting a map to the communication device, wherein the map corresponds to an area including the approximate geographic location of the communication device.

21 (currently amended). The method of claim 20, wherein the step of receiving the more accurate geographic location comprises the step of receiving information from the user input device identifying a location of the communication device on the map.

22 (currently amended). A method for a communication device to assist a system infrastructure of a wireless communication system with a user input device in

Application No. 09/769,939
January 26, 2005
Page 20 of 25

Docket No. PT01763NA

providing an accurate geographic location of the communication device to a target device, the method comprising the steps of:

- receiving, from the system infrastructure, at least a request for an accurate geographic location of the communication device;
- displaying the request ~~to a user of~~ on the communication device;
- receiving, from the user input device, the accurate geographic location of the communication device; and
- transmitting the accurate geographic location to the system infrastructure for subsequent delivery to the target device.

23 (original). The method of claim 22, wherein the step of receiving at least a request further comprises the step of receiving a map of an area that includes an approximate location of the communication device.

24 (original). The method of claim 23, wherein the step of displaying further comprises the step of displaying the map to the user.

25 (currently amended). The method of claim 24, wherein the step of receiving the accurate geographic location further comprises the step of receiving from the user input device an indication on the map corresponding to a location of the communication device.

26 (original). The method of claim 25, wherein the step of transmitting the accurate geographic location further comprises the step of transmitting a modified representation of the map that includes the indication corresponding to the location of the communication device.

Application No. 09/769,939
January 26, 2005
Page 21 of 25

Docket No. PT01763NA

27 (currently amended). The method of claim 24, wherein the step of receiving the accurate geographic location further comprises the steps of:

receiving from the user input device an indication on the map corresponding to a second approximate location of the communication device, the second approximate location being more accurate than the approximate location; and

receiving from the user input device a request for a second map corresponding to an area that includes the second approximate location of the communication device, the second map being of a higher resolution than the map of the area that includes the approximate location of the communication device.

28 (original). The method of claim 27, wherein the step of transmitting the accurate geographic location further comprises the step of transmitting the second approximate location of the communication device and the request for the second map.

29 (currently amended). The method of claim 28, further comprising the steps of:

receiving the second map;

displaying the second map to the user; and

receiving, from the user input device, an indication on the second map corresponding to a location of the communication device to produce the accurate geographic location of the communication device.

30 (original). The method of claim 29, wherein the step of transmitting the accurate geographic location comprises the step of transmitting a modified representation of the second map that includes the indication corresponding to the location of the communication device.

31 (original). The method of claim 22, wherein the accurate geographic location of the communication device includes information indicating a height of the communication

Application No. 09/769,939
January 26, 2005
Page 22 of 25

Docket No. PT01763NA

device.

32 (original). The method of claim 22, further comprising the steps of:
prior to receiving at least the request,

receiving a map of an area that includes an approximate geographic
location of the communication device; and

storing the map in a memory of the communication device;

wherein the step of displaying comprises the step of automatically displaying the map
responsive to receiving the request and wherein the step of receiving the accurate
geographic location comprises the step of receiving an indication on the map
corresponding to a location of the communication device.

33 (currently amended). A method for a communication device with a user input
device to assist a system infrastructure of a wireless communication system in
providing an accurate geographic location of the communication device to a target
device, the method comprising the steps of:

receiving, from the system infrastructure, a request for an accurate geographic
location of the communication device and a map of an area that includes an
approximate geographic location of the communication device;

displaying at least the map ~~to a user of~~ on the communication device;

receiving, from the user input device, an indication on the map corresponding to
a location of the communication device; and

conveying the location of the communication device to the system infrastructure
for subsequent delivery to the target device.

34 (original). The method of claim 33, wherein the location of the communication device
comprises information indicating a height of the communication device.

Application No. 09/769,939
January 26, 2005
Page 23 of 25

Docket No. PT01763NA

35 (currently amended). A method for a communication device with a user input device to assist a system infrastructure of a wireless communication system in providing an accurate geographic location of the communication device to a target device, the method comprising the steps of:

- receiving, from the system infrastructure, a request for an accurate geographic location of the communication device and a first map of an area that includes a first approximate geographic location of the communication device;

- displaying at least the first map ~~to a user of~~ on the communication device;

- receiving, from the user input device, an indication on the first map corresponding to a second approximate geographic location of the communication device, the second approximate geographic location being more accurate than the first approximate geographic location;

- conveying the second approximate geographic location and a request for a second map to the system infrastructure;

- receiving the second map from the system infrastructure, the second map corresponding to an area that includes the second approximate geographic location and being of a higher resolution than the first map;

- displaying the second map ~~to the user of~~ on the communication device;

- receiving, from the user input device, an indication on the second map corresponding to a location of the communication device; and

- conveying the location of the communication device to the system infrastructure for subsequent delivery to the target device.

36 (currently amended). A communication device comprising:

- a receiver for receiving, from a system infrastructure of a wireless communication system, at least a request for an accurate geographic location of the communication device;

- a display, operably coupled to the receiver, for displaying the request ~~to a user~~

Application No. 09/769,939
January 26, 2005
Page 24 of 25

Docket No. PT01763NA

on the communication device;

a user input device for receiving, from the user, information corresponding to the accurate geographic location of the communication device; and

a transmitter, operably coupled to the user input device, for transmitting the accurate geographic location to the system infrastructure for subsequent delivery to a target device.

37 (original). The communication device of claim 36, wherein the at least a request includes a map of an area that includes an approximate location of the communication device.

38 (original). The communication device of claim 37, wherein the display further displays the map.

39 (original). The communication device of claim 38, wherein the information corresponding to the accurate geographic location of the communication device comprises an indication on the map corresponding to a location of the communication device.

40 (original). The communication device of claim 36, wherein the user input device comprises at least one of a keypad, a computer mouse, a touchpad, a touchscreen, a trackball, and a keyboard.

41 (currently amended). A communication device comprising:

a receiver for receiving, from a system infrastructure of a wireless communication system, a request for an accurate geographic location of the communication device and a map of an area that includes an approximate geographic location of the communication device;

Application No. 09/769,939
January 26, 2005
Page 25 of 25

Docket No. PT01763NA

a display, operably coupled to the receiver, for displaying at least the map to a user ~~on~~ of the communication device;

a user input device for receiving, from the user, an indication on the map corresponding to a location of the communication device; and

a transmitter, operably coupled to the user input device, for transmitting the location of the communication device to the system infrastructure.

42 (original). The communication device of claim 41, wherein the user input device comprises at least one of a keypad, a computer mouse, a touchpad, a touchscreen, a trackball, and a keyboard.